



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,720	01/15/2002	Larry Voss	80121-06551	8993

758 7590 08/04/2003

FENWICK & WEST LLP
SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041

EXAMINER

COMSTOCK, DAVID C

ART UNIT	PAPER NUMBER
----------	--------------

3732

DATE MAILED: 08/04/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

10/051,720

Applicant(s)

VOSS ET AL.

Examiner

David C. Comstock

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: .

DETAILED ACTION

Claim Objections

Claims 18 and 19 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 18 and 19 are duplicates of claims 2 and 3, respectively, and accordingly, are withdrawn from consideration.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 6, and 10 are rejected under 35 U.S.C. 102(a) as being anticipated by Spence et al. (6,019,722; cited by applicant).

Spence et al. disclose a surgical support 50 comprising a contact member 52, and a support structure 64 (see Figs. 3, 5, 7A, and 15). The support structure comprises balls 90 and interposed ring elements 92 held together in a locked configuration by a flexible tensioning element 94,96 passing through an internal bore in the balls and ring elements (Fig 7A). The tensioning element attaches to the distal end and passes through the support structure to the proximal end to an adjustment

apparatus 240, which allows the wire to be tightened and locked into a desired position (Fig. 15).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spence et al. (6,019,722; cited by applicant) in view of Blanco et al. (5,348,259).

Spence et al. disclose the claimed invention except for the tapered inner bore. Blanco et al. disclose a similar device having a tapered inner bore 36 to accommodate a tensioning cable during bending and facilitate smooth operation of the device (see Figs. 1 and 4 and col. 3, lines 34-37). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the support of Spence et al. with tapered inner bores, in view of Blanco et al., in order to accommodate the tensioning cable during bending and facilitate smooth operation of the device.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spence et al. (6,019,722; cited by applicant) in view of Wagenknecht (5,098,432).

Spence et al. disclose the claimed invention except for the discontinuous contact surfaces and stepped edges 117,118. Wagenknecht discloses a ball-and-joint device comprising discontinuous contact surfaces and stepped edges for increasing frictional engagement of the joint and prevent undesired motion (see Fig. 14 and col. 6, lines 43-

56). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the support of Spence et al. with discontinuous contact surfaces and stepped edges, in view of Wagenknecht, in order to increase frictional engagement of the joints and prevent undesired motion

Claims 7, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spence et al. (6,019,722; cited by applicant) in view of Corey Jr. et al. (5,899,425; cited by applicant).

Spence et al. disclose the claimed invention except for the shoulder. Corey Jr. et al. disclose a similar device 24 having a shoulder 176 on the outside of spherical portion 158 of a ball-and-socket joint to limit the angular articulation of the joint and prevent the tensioning cable from being pinched (see Figs. 1 and 6 and col. 6, lines 7-20). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the support of Spence et al. with shoulder on the outside of spherical portion of the ball-and-socket joint, in view of Corey Jr. et al., in order to limit the angular articulation of the joint and prevent the tensioning cable from being pinched. Corey Jr et al. also disclose a lateral bar 124 and channel 130 at the end of the support. The bar and channel form a joint 26 which allows the device to be adjusted relative to the support to improve the convenience and functionality of the device (see col. 5, lines 22-31). It would have also been obvious to provide a lateral bar at the end of the support and a lateral channel at the support end and connected to the bar in order to permit the device to be adjusted relative to the support and improve the convenience and functionality of the device.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spence et al. (6,019,722; cited by applicant).

Spence et al. disclose the claimed invention except for the ring element being formed of a resilient material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the ring elements of a resilient material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spence et al. (6,019,722; cited by applicant) in view of Sienkiewicz et al. (5,803,902).

Spence et al. disclose the claimed invention except for the textile material, rayon fibers, non-woven fibers, etc. on the contact member. Sienkiewicz discloses a surgical device 10 having a covering 20 of fabric, surgical mesh, nylon, latex, etc. to allow an organ to be grasped without damage and to improve the safety of the procedure (see Fig. 1, col. 1, lines 46-49, col. 4, lines 34-37, and col. 4, line 66 - col. 5, line 18). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the support of Spence et al. with a covering of fabric, surgical mesh, nylon, latex, etc., in view of Sienkiewicz, in order to allow an organ to be grasped without damage and to improve the safety of the procedure. It would have been further obvious to form the contact member covering of rayon, non-woven fibers, etc. since it has, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious

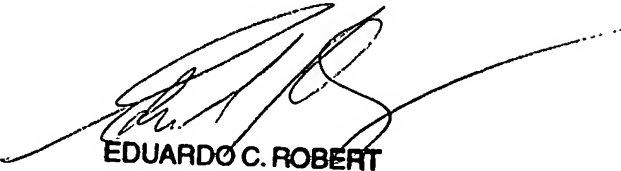
design choice. *In re Leshin*, 125 USPQ 416. It also would have been obvious to form the covering with a thickness in the range of .015 inches - .064 inches, or any such thickness, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Comstock whose telephone number is (703) 308-8514.

D.C. Comstock
July 26, 2003



EDUARDO C. ROBERT
PRIMARY EXAMINER